

## **DETAILED ACTION**

### **Acknowledgement**

1. Acknowledgement is made of applicant's amendment made on 05/05/2008. Applicant's submission filed has been entered and made of record.

### ***Response to Applicant's Arguments***

2. Rejections made under 35 USC 112 2<sup>nd</sup> paragraph are withdrawn.
3. **Applicant argued, with respect to the rejections of Claims 1 and 17, that by teaching “that the hardcopy prints are digitally scanned and the digital image is analyzed in accordance with the predetermined criteria based on the information obtained by scanning the images, Testa et al. teaches away from the above limitations of amended independent claims 1 and 17”. Specifically, “recording the spatial location of the user applied indicia on the proof-sheet via a pen that applies the user-applied indicia”. The examiner disagrees.**

The examine respectfully submits that ***Testa*** does not teach away from the claimed limitation because ***Testa*** teaches an instruction form 74 or proof sheet or a piece of paper (**Fig 6A and see Col 7, Rows 12-34 and see Col 4, Row 65 – Col 5, Row 4**) having a designation area for a user to manually fill in instructions, via a writing stylus such as a pen, for manipulating images (**Col 4, Row 65 – Col 5, Row 4 and see Col 8, Rows 5-15**) and send said instructions to the printer to be implemented via optical character recognition technology (**Col 8, Rows 15-25**). As such, user-applied instructions or indicia located at

various spatial locations 86, 88, and 89 are optically recognized so that said spatial locations are transmitted to the printer.

**Hicks** disclose the same limitation as well (**Col 4, Rows 16-25**).

In conclusion, the examiner does not see as to how the application of optical recognition technology teaches away from the claimed limitation. Therefore, the prior arts of record meet the claimed limitation.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 10-12, 14, and 16-17 are rejected under 35 USC 103 (a) as being unpatentable over ***Testa et al. (US 6745186 B1)*** in view of ***Hicks (US 5359387 A)***.

**Regarding Claim 1**, ***Testa*** discloses a method of manipulating digitally stored images (**Col 4, Row 65- Col 5, Row 4**), the method including:

recording and storing digital representations of one or more images (**Col 4, Rows 57-64**);  
transferring one or more of the plurality of digital images to a printer configured to generate representations of selected ones of the plurality of images (**Col 5, Rows 5-25 and see Col 13, Rows 9-14**);

the printer generating a proof-sheet (**Fig 6A and see Col 7, Row 29-Col 8, Row 25**) incorporating a graphical representation of at least one of the images (**Col 7, Rows 29-34, pre-print sticker 80 on location 78 whereas the sticker is a graphical representation of the image that follows the proof sheet**) and image manipulation user designation areas (**Col 8, Rows 5-25**), wherein the proof-sheet is further adapted to include location information which identifies any physical spatial location on the surface of the proof-sheet (**Col 8, Rows 5-25, as it is very well known in the art as OCR, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed**);

recording the spatial location of user-applied indicia on the proof-sheet via a pen that applies the user-applied indicia to at least one of the user designation areas on the proof-sheet (**Fig 6A and see Col 8, Rows 5-25, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed. Implicitly, a handheld stylus generally known as a pen is needed for handwritten entry of the instruction**); and

transmitting the spatial location of the user-applied indicia to the printer (**Col 13, Row 32 – Col 14, Row 30, transmitting the information including images and instruction sheet to the retailer over a communication line network where retailer's printers for processing the order are located**).

*Testa* does not disclose the proof sheet incorporating at least one of a plurality of image selection.

***Hicks* discloses a proof sheet (Col 4, Rows 16-26, OCR readable proof sheet with handwritten customer instructions) incorporating at least one of a plurality of image selection (Fig 2 with customer instruction on the bottom and see Col 3, Rows 21-36).**

It would've been obvious to one of ordinary skill in the art at the time of the invention to incorporate a proof sheet that comprises a plurality of image selection so as to visually aid the customer in selecting the desired instructions by producing final positive photographic prints of a single subject from a plurality of varying photographic exposures of the subject representing varying poses (***Hicks, Col 1, Row 66 – Col 2, Row 2***).

**Regarding Claim 2, *Testa* discloses causing the printer (retailer's printer) to translate the spatial location of the user-applied indicia into at least one of printing and image manipulation commands (Col 8, Rows 5-25).**

**Regarding Claim 3, *Testa* discloses wherein the spatial location information of the user-applied indicia and images are printed concurrently (Fig 23 and see Col 8, Rows 20-25, the images are processed or printed in accordance to the information provided at the spatial location. As such, the instruction is in essence printed with the images concurrently).**

**Regarding Claim 4, *Testa* discloses printing the one or more images based on the spatial location information of the user-applied indicia (Col 8, Rows 20-25, the images are processed or printed in accordance to the information provided at the spatial location).**

**Regarding Claim 5, *Testa* discloses printing the one or more images based on the spatial location information of the user-applied indicia (Col 8, Rows 20-25, the images are processed or printed in accordance to the information provided at the spatial location).**

**Regarding Claim 6, *Testa* discloses storing the one or more images stored on read/write capable media, the printer being adapted to receive the media therein to read the data stored thereon (Col 5, Rows 48-61 and see Col 13, Rows 59-65).**

**Regarding Claim 7, *Testa* discloses causing the printer to receive the media therein and read the data stored thereon (Col 5, Rows 48-61 and see Col 13, Rows 59-65).**

**Regarding Claim 10, *Testa* discloses wherein the position of the user-applied indicia are recorded by optically imaging the glyphs at the time that the user-applied indicia are applied (Col 8, Rows 5-25).**

**Regarding Claim 11, *Testa* discloses wherein data related to the position of the user-applied indicia are recorded by the pen (Fig 6A and see Col 8, Rows 5-25, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed. Implicitly, a handheld stylus generally known as a pen is needed for handwritten entry of the instruction), then transmitted to the printer (Col 13, Row 32 – Col 14, Row 30, transmitting the information including images and instruction sheet to the retailer over a communication line network where retailer's printers for processing the order are located).**

**Regarding Claim 12, *Testa* discloses wherein the data relating to the position of the user-applied indicia are transmitted to the printer substantially continuously, buffered for**

transmission or otherwise streamed (**Col 13, Row 32 – Col 14, Row 30. As it is very well known for communication over the network where data transmitted are continuously transferred and buffered at the end location or otherwise streamed**).

**Regarding Claim 14, Testa** discloses wherein the data are transmitted via a wireless link, a physical cable, or an optical link (**Col 13, Rows 59-66**).

**Regarding Claim 16, Hicks** discloses wherein the glyphs are printed on the proof-sheet substantially concurrently with the image representations (**Col 3, Rows 21-28**).

**Regarding Claim 17, Testa** discloses a digital image processing system (**Fig 22**) including:

a printer adapted to receive image data relating to one or more digital images taken by a user (**Col 13, Row 32 - Col 14, Row 30, inherently, there must be a printer at the retailer that prints both the proof sheet and the images as ordered so that proof sheet and its associated labels are printed and images are processed in accordance to user instruction**), the printer further adapted to produce a proof-sheet detailing the graphical images (**Fig 6**);

and a pen (**Fig 6A and see Col 8, Rows 5-25, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed. Implicitly, a handheld stylus generally known as a pen is needed for handwritten entry of the instruction**);

the paper and pen being arranged so that

(a) user-applied indicia corresponding to image manipulation commands applied by the user with the pen to the proof-sheet are adapted to be transmitted to the printer by recording, via the pen, the spatial position of the user-applied indicia (**Col 13, Row 32 – Col 14, Row 30, transmitting the information including images and instruction sheet to the retailer over a communication line network where retailer's printers for processing the order are located**) and

(b) the recorded spatial position of the user-applied indicia are adapted to be transmitted to the printer (**Col 13, Row 32 – Col 14, Row 30, inherently, there must be a printer at the retailer that prints both the proof sheet and the images as ordered so that proof sheet and its associated labels are printed and images are processed in accordance to user instruction**).

6. Claims 8-9 and 15 are rejected under 35 USC 103 (a) as being unpatentable over the combined teachings of *Testa et al. (US 6745186 B1)* and *Hicks (US 5359387 A)* in view of *Jared et al (US 6208771 B1)*.

**Regarding Claim 8**, the combined teaching does not disclose wherein the sheet has a plurality of glyphs that provide position information to the pen, and communicating said position information to the printer.

*Jared* discloses wherein the sheet has a plurality of glyphs that provide position information to the pen, and communicating said position information to a data processing apparatus (**Col 11, Rows 32-54, the data processing apparatus being a computer that collects the glyph position information via the pen**).

It would've been obvious to one of ordinary skill in the art at the time of the invention to adapt a stylus pen that can transmit cursive handwritten glyphs to a data processing apparatus such as a computer or printer in order to accurately and conveniently transmit a plurality of handwritten instructions to the data processing apparatus so that user's desired orders are processed.

**Regarding Claim 9, *Jared*** discloses wherein the position of the pen is detected using a position location system based on infra-red detection, electromagnetic spatial orientation (**Col 12, Rows 1-23, glyph orientation detection via scanning, which involves electromagnetic spectrum analysis of the light reflected off the surface**) or the like.

**Regarding Claim 15, *Jared*** discloses wherein the data are transmitted to the printer at the instigation by a user activating a switch or sensor on the pen (**Col 11, Rows 46-53**).

7. Claim 13 is rejected under 35 USC 103 (a) as being unpatentable over the combined teachings of ***Testa et al. (US 6745186 B1)*** and ***Hicks (US 5359387 A)*** in view of ***Chai (US 6393138 B1)***.

**Regarding Claim 13,** the combined teaching does not disclose wherein the data relating to the position of the user-applied indicia are transmitted using a wireless communication means.

***Chai*** discloses a system that employs a wireless stylus for OCR (**See Background, Col 1-2**) wherein data relating to the position of the user-applied indicia are transmitted using a wireless communication means (**Col 2, Rows 40-48**).

It would've been obvious to one of ordinary skill in the art at the time of the invention to adapt a wireless means for transmitting spatial location information in order to provide the

user with a convenient apparatus without the draw backs of a wired system, such as hardware interface and burden of technical knowledge to properly connect the apparatus to a data processing apparatus such as a printer or a computer.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Richard Z. Zhu whose telephone number is 571-270-1587 or examiner's supervisor King Y. Poon whose telephone number is 571-272-7440. Examiner Richard Zhu can normally be reached on Monday through Thursday, 7:30 - 4:00.

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Richard Z. Zhu  
Assistant Examiner  
Art Unit 2625

/King Y. Poon/

Supervisory Patent Examiner, Art Unit 2625